Subject Index.

	Page
PETITION	1
Short summary statement of the matter involved	2
The prior proceedings	2
The mechanism and invention of the patent in suit	3
Claim 7 is narrower than invalid claim 8 which was disclaimed	4
The Court of Appeals failed to follow the test set out by this Court in Maytag Co. v. Hurley Machine Co.	6
Questions presented	6
Reasons relied on for allowance of the writ	7
Prayer	8
BRIEF	9
Opinions of the courts below	9
Jurisdiction	9
Statement of the case	9
Specification of errors	10
Summary of argument	10
Argument	12
I. Claims which contain additional elements are narrower than those which do not and are "definitely distinguishable"	12
II. Claim 7, which the Court of Appeals said should have been disclaimed, is narrower in scope than disclaimed claim 8 since it includes as limitations three additional features not found in claim 8	13
III. The differences in the wording of the claims describe differences in the operation and result of the machines	14
IV. The Court of Appeals failed to apply the test of the Maytag case	16

Page

V. The Court of Appeals has given the claims of the patent in suit a different meaning from that given to them by that court in the Ditto case; in filing its disclaimer, petitioner relied on that interpretation; it should not be penalized for the changed views of the Court of Appeals and did not "unreasonably neglect" to file a disclaimer 17

VI. The public interest requires that the disclaimer statute should be clearly and definitely construed 18

Conclusion 19

Appendix A 20

Opinion in Standard Mailing Machines Co. v. Ditto, Inc., 100 F. (2d) 466 20

Appendix B 28

Revised Statutes, sec. 4917 28

Revised Statutes, sec. 4922 29

Appendix C 29

Revised Statutes, sec. 4888 29

Table of Authorities Cited.

CASES.

E. L. Bruce Co. v. Bradley Lumber Co., 79 F. Supp. 176 11, 16, 17, 18

France Mfg. Co. v. Jefferson Elec. Co., 106 F. (2d) 605 18n.

Hailes v. Albany Stove Co., 123 U.S. 582 10n.

Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 12, 14

Hubbell v. United States, 179 U.S. 77 13

I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429 13

Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274 12

Maytag Co. v. Hurley Machine Co., 307 U.S. 243 10, 11, 14, 16, 19

	Page
McClain v. Ortmayer, 141 U.S. 419	12
Standard Mailing Machines Co. v. Ditto, Inc., 22 F. Supp. 722	9, 11, 17
Standard Mailing Machines Co. v. Ditto, Inc., 100 F. (2d) 466	9
T. H. Symington Co. v. National Malleable Castings Co., 250 U.S. 383	12
Weber Electric Co. v. Fineman Electric Co., 256 U.S. 668	13
W. F. & John Barnes Co. v. International Harvester Co., 51 F. Supp. 254	18n.

STATUTES.

R.S. sec. 4888	14, 19
R.S. sec. 4917, 35 U.S. sec. 65	10
R.S. sec. 4922, 35 U.S.C. sec. 71	10, 14
28 U.S.C. 1254	9

Supreme Court of the United States.

OCTOBER TERM, 1949.

STANDARD DUPLICATING MACHINES COMPANY, INC.,
Petitioner,
v.
AMERICAN BUSINESS MACHINES CORPORATION,
Respondent.

PETITION OF STANDARD DUPLICATING MACHINES COMPANY, INC., FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Standard Duplicating Machines Company, Inc., plaintiff, respectfully prays for a writ of certiorari to the United States Court of Appeals for the First Circuit to reverse a judgment of that court entered on April 22, 1949, rehearing denied May 19, 1949. A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

Short Summary Statement of the Matter Involved.

This is a patent case and involves the interpretation of the disclaimer statutes (R.S. Secs. 4917 and 4922, 35 U.S.C. Secs. 65 and 71) and more particularly the words "definitely distinguishable" in Section 4922. The primary question is whether two claims, one of which is narrower than the other, *i.e.*, of different scope, are on that account "definitely distinguishable" from each other. This question has never been decided by this Court, but the decision of the Court of Appeals in the case at bar is squarely in conflict with the decision of the District Court in *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176, and fails to follow the test laid down by this Court in *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243.

The Prior Proceedings.

This action was brought by petitioner in the District Court for the District of Massachusetts to enjoin infringement of Letters Patent Reissue No. 19,951 for wet process duplicating machines, dated April 28, 1936, to Frederick W. Storck, assignor to Standard Mailing Machines Company, which by change of name is now the Standard Duplicating Machines Company, Inc., petitioner herein.

In an earlier suit (*Standard Mailing Machines Company* v. *Ditto, Inc.*,* 22 F. Supp. 722; 100 F. (2d) 466) in the District of Massachusetts, the Court of Appeals for the First Circuit held claim 8 invalid and claims 3, 19, 20, 21, 22, 29, 30, 32, 34 and 40 valid and infringed.

On January 31, 1939, petitioner filed a disclaimer to invalid claim 8 (R. p. 20).

On December 18, 1947, petitioner filed its complaint in the present case. On February 19, 1948, respondent (de-

*Hereafter referred to as the *Ditto* case. The decision of the Court of Appeals is printed in the Appendix to this brief.

fendant) filed a motion to dismiss, claiming that "the patent in suit is invalid on its face as to all claims by reason of plaintiff's failure to file a disclaimer of claims 7, 9, 12 and 15 . . . since claims 7, 9, 12 and 15 are not 'definitely distinguishable' from the subject matter of claim 8 which was disclaimed by petitioner on January 31, 1939" (R. p. 21). Infringement of claims 7, 9, 12 and 15 was not charged, and the grounds stated by the Court of Appeals for holding claim 8 invalid in the *Ditto* case did not apply to these claims.

On May 21, 1948, the District Court entered a judgment of dismissal (R. p. 22; Opinion, R. pp. 22-28) ruling that, notwithstanding their limitations, claims 7, 9 and 12* were not "definitely distinguishable" from invalid claim 8. On April 22, 1949, the Court of Appeals for the First Circuit affirmed the judgment, but discussed only claim 7 (R. p. 83).

A petition for rehearing (R. p. 85) was denied on May 19, 1949 (R. p. 97).

The Mechanism and Invention of the Patent in Suit.

In the Storck machine a master copy, which is printed in reverse with soluble ink, is fastened to a revolving drum or platen 4 (Fig. 3, R. p. 7) in front of which there is a pair of rolls 25, 26, which are stationary during part of the cycle of the machine and during the remainder rotate with the same surface speed as the drum. While the rolls are stationary, a clear copy sheet is pushed against the bight of the rolls and positioned by them. As the rolls revolve, one of them (26) moistens the paper with fluid received from a wick 45, the lower end of which is in a tank 43 filled with fluid. Rotation of the rolls also feeds the paper to the

*The District Judge also ruled that claim 15 was definitely distinguishable and need not have been disclaimed (R. p. 28).

drum, where it is pressed against the master copy, thereby producing the duplicate copy. Thus the rolls perform three functions—positioning, feeding and moistening. Storck taught the public three things: (1) How to moisten a clear sheet satisfactorily, (2) how to arrange a machine so that a pair of rolls not only feed and moisten the clear sheets, but also position them with respect to the master copy on the drum, and (3) how to change the position of the printing on the clear copy. The first was accomplished by using a wick to convey moisture from the tank to the moistening roll; the second by an intermittent gear which causes the rolls to effect a dwell period during which the clear copy can be positioned against their bight, and the third by providing adjustable mechanism for the intermittent gearing.

Claim 7 is Narrower than Invalid Claim 8 which was Disclaimed.

Disclaimed claim 8* was held invalid in the *Ditto* case (App. p. 22) because it was "not sufficiently limited to escape the prior art," *i.e.*, because it was too broad.

It was too broad in two respects: (1) Because it called for "means for intermittently rotating" the printing platen and rolls in unison. It therefore was functional at the

*"8. In a machine for producing duplicate copies of matter printed in reverse on a master sheet, a frame, a printing platen revolvably mounted in said frame, means for securing said master sheet to said printing platen, *means for intermittently rotating* said printing platen, a pair of feed rolls for feeding a clear sheet of paper, *means for applying* a limited film of volatile moistening fluid to the face of one of said feed rolls to be deposited on a clear sheet of paper as it passes between said pair of feed rolls, means for revolving said feed rolls in unison with the rotative movement of the printing platen and a pressure roll for pressing the clear sheet against the master copy."

exact point of novelty, and also covered a prior art machine which obtained this result, but did not use the rolls to position the paper. (2) Because it called for means for "applying . . . moisture to the rolls," and so was broad enough to cover not only a wick (one end of which applies moisture to the roll) but also a machine in which the moistening roll dips directly in the fluid, such as the alternative construction shown in Fig. 9 of the Storck patent, a construction which the patentee erroneously thought to be novel.

Claim 7,* which the Court of Appeals in the case at bar held not "definitely distinguishable" from claim 8, is narrower in three respects: It is limited (1) to the use of an intermittent gear, which provides a dwell during which the rolls position the paper (R. p. 15, lines 23-30) and thus specified the particular mechanism by which the function stated in claim 8 was achieved, (2) to the use of "conveying means," which covers the use of a wick (Fig. 4) but does not cover the direct application of the fluid as shown in Fig. 9, and (3) to the use of an adjustable fastening for the intermittent gear by which the location of the printed matter on the clear copy sheet can be varied. Each of these limitations is important. Each relates to a point of novelty, and each describes mechanism which made the patented machine successful where others had failed. Each

*"7. In a machine for producing duplicate copies of matter imprinted in reverse on a master sheet with copying ink, a stationary frame, a printing platen rotatably mounted in said stationary frame, *an intermittent gear adjustably secured* to said printing platen to intermittently rotate it, combined feeding and moistening rolls mounted in said stationary frame, means to convey moistening fluid to one of said rolls, means for rotating said feeding and moistening rolls in unison with said printing platen to feed a clear sheet to contact with a master sheet secured to said printing platen and means to press said clear sheet against the master sheet."

of the mechanisms also produced a difference in operation and result.

Although claim 7 is narrower than and different in scope from invalid claim 8, the Court of Appeals held that claim 7 was not "definitely distinguishable" from claim 8.

The Court of Appeals Failed to Follow the Test Set Out by This Court in Maytag Co. v. Hurley Machine Co.

In *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243, this Court held that two method claims, which were the same except in verbiage, and which did not describe any difference in "operation or result," were not "definitely distinguishable" within the meaning of the disclaimer statute, thus making a difference in "operation or result" the test. The Court of Appeals for the First Circuit has gone contrary to the *Maytag* decision and has held claim 7 not "definitely distinguishable" from disclaimed claim 8 even though claim 7 describes important differences in both operation and result which were largely responsible for the acknowledged success of the invention of the patent in suit. The Court of Appeals came to this wrong conclusion because it erroneously attributed significance to the fact that the differences set out in claim 7 did not limit the claim in the same manner and to the same extent as the claims held valid in the prior litigation.

Questions Presented.

This case, therefore, raises the following questions:

1. What is the proper construction of the words "definitely distinguishable" in the disclaimer statute?

2. Does not a difference in scope between two claims at the exact point of novelty render them "definitely distinguishable"?

3. When a claim is held invalid because it was not sufficiently limited to escape the prior art, is not another claim which is more narrowly limited and does escape the prior art definitely distinguishable from the first claim?

4. Is not a claim which sets out the structure of a device and thereby "distinctly claims" it as required by R.S. Sec. 4888, therefore "definitely distinguishable" from a claim which does not?

5. Under the circumstances of the case at bar was it "unreasonable neglect" within the meaning of the statute to fail to disclaim the retained claims?

Reasons Relied on for Allowance of the Writ.

Petitioner respectfully prays that the writ be allowed for the following reasons:

1. Because the case involves the interpretation of the Federal statutes, to wit R.S. Sec. 4922 (U.S.C. Sec. 71).

2. Because the Court of Appeals for the First Circuit has adopted a construction of the statute contrary to that given it by this Court in *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243.

3. Because the public interest requires that the disclaimer statute shall be clearly and precisely construed with respect to the meaning of the phrase "definitely distinguishable" so that the public may know whether or not it is necessary to disclaim claims which are narrower than broader invalid ones.

4. Because important questions of federal law are presented which have not been but should be decided by this Court.

Prayer.

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Court of Appeals for the First Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete description of the record and all proceedings of the case entitled on its docket 4376, *Standard Duplicating Machines Co., Inc., plaintiff-appellant,* v. *American Business Machines Co., Inc., defendant-appellee,* and that the said decree of the Court of Appeals for the First Circuit may be reviewed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as this Honorable Court may see meet and just; and your petitioner will ever pray.

GEORGE P. DIKE,
GEORGE P. TOWLE, JR.,
Attorneys for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court for the District of Massachusetts (Sweeney, D.J.) appears at page 22 of the record and is reported in 77 F. Supp. 871. The opinion of the Court of Appeals for the First Circuit appears at page 71 of the record and is reported in 174 F. (2d) 101. The opinion of the District Court for the District of Massachusetts in *Standard Mailing Machines Co.* v. *Ditto, Inc.*, is reported in 22 F. Supp. 722, and of the Court of Appeals for the First Circuit in 100 F. (2d) 466 (Appendix A).

Jurisdiction.

The grounds for jurisdiction are:

1. The date of the judgment to be reviewed is April 22, 1949 (R. p. 83). Petition for rehearing was denied May 19, 1949 (R. p. 97).

2. The judgment was rendered in a civil action brought under the patent statute to determine the issues of validity and infringement of letters patent of invention.

3. The statute under which jurisdiction is given is New Title 28 U.S.C. 1254.

Statement of the Case.

The essential facts of the case are stated in the accompanying petition and need not be repeated here.

Specification of Errors.

The errors which petitioner will urge if the petition for certiorari is granted are that the Court of Appeals for the First Circuit erred:

1. In holding that claim 7* of the Storck patent in suit Reissue No. 19,951 is not definitely distinguishable from disclaimed claim 8 of said patent, and that the patent as a whole is invalid because said claim was not disclaimed.

2. In construing the words "definitely distinguishable" in the disclaimer statute and in effect holding that, although the claims are different in scope, they are not on that account "definitely distinguishable."

3. In putting a different construction on the words "definitely distinguishable" in the disclaimer statute from that put on them by this Court in *Maytag Co.* v. *Hurley Machine Co.*

4. In holding a claim which "distinctly claims" an invention is not "definitely distinguishable" from one which does not.

Summary of Argument.

The disclaimer statutes, Revised Statutes, Secs. 4917 and 4922, 35 U.S.C. Secs. 65 and 71, quoted in full in the Appendix, provide that, when a patentee has claimed more than was "truly and justly his own," he may file a disclaimer, and that, when this is done, his patent, which at common law was invalid as a whole, becomes valid for the part not disclaimed.† The essential parts of the disclaimer statute, Sec. 4922, so far as the present case is concerned, are the requirements that the "parts" remaining after the

*The Court of Appeals did not rule as to claims 9 and 12 on the ground that it was sufficient to rule on claim 7.

†*Hailes* v. *Albany Stove Company*, 123 U.S. 582, 589.

disclaimer shall be "definitely distinguishable from the parts claimed without right," and that the disclaimer shall have been filed without "unreasonable neglect."

The present case involves the construction of the phrase "definitely distinguishable" and the application of the phrase "unreasonable neglect."

In *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243, this Court held that two method claims (38 and 39) of a patent relating to a washing machine, which differed from each other only "in verbiage" and did not describe any difference in "operation or result," were for the same method and therefore were not "definitely distinguishable." Thus, this Court appears to have construed the disclaimer statutes to make "difference in operation or result" the test of whether two claims are "definitely distinguishable." The claims in the case at bar satisfy this test.

In the case at bar, claim 7 contains limitations not found in invalid claim 8, and differs from it not only in verbiage but also in operation and result. The Court of Appeals failed to give effect to the resulting difference in scope and held the claims not "definitely distinguishable," thus ignoring inherent differences in result and operation which the District Judge had observed, and going contrary to the decision of Judge Miller in *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176, in which it was held that two claims which differed in scope were "definitely distinguishable."

The decision on the patent in suit in the *Ditto* case construed the patent in suit. The patentee accepted the decision and acted on it and forthwith disclaimed invalid claim 8. The court has now taken a different view of why the invention was patentable and has construed the patent differently. If the court's present position is correct, its original opinion was misleading. The patentee relied on the original decision of the court and was not guilty of "unreasonable neglect" in filing a disclaimer, because it

could not have been expected to foresee a change by the Court of Appeals in its interpretation of the patent.

Argument.

I. Claims which contain additional elements are narrower than those which do not and are "definitely distinguishable."

A claim is broader if it omits an element; and is narrower if it includes an additional element. To illustrate, if a claim contains three elements *a*, *b*, and *c*, it will be infringed by a device which contains these three elements even if the alleged infringing device contains additional elements *d* and *e*, because the combination *a*, *b*, *c*, *d*, *e* includes the three elements *a*, *b*, *c*. On the other hand, a claim for the combination *a*, *b*, *c*, *d*, *e* is a narrower claim and it will not be infringed by a device which contains only *a*, *b*, *c*, because that device does not contain elements *d* and *e* which have been made essential parts of the combination *a*, *b*, *c*, *d*, *e*.

For cases of infringement in which this principle has been applied, see—

T. H. Symington Co. v. *National Malleable Castings Co.*, 250 U.S. 383, 385.
McClain v. *Ortmayer*, 141 U.S. 419, 423.
Keystone Bridge Co. v. *Phoenix Iron Co.*, 95 U.S. 274.

Likewise, a more specific definition of one of the elements makes a claim narrower.

Halliburton Oil Well Cementing Co. v. *Walker*, 329 U.S. 1, 9.

In cases of file wrapper estoppel, the cancellation or amendment of a claim is in effect a disclaimer of the original claim, see—

I.T.S. Rubber Co. v. *Essex Rubber Co.*, 272 U.S. 429, 443-444.
Hubbell v. *United States*, 179 U.S. 77.
Weber Electric Co. v. *Fineman Electric Co.*, 256 U.S. 668, 677.

Therefore, when infringement, file wrapper estoppel or the requirement to "distinctly claim" are in question, claims are "definitely distinguishable" if one claim is narrower than another. We respectfully submit that, when the applicability of the disclaimer statute is in question, the same rule should be applied.

II. Claim 7,* which the Court of Appeals said should have been disclaimed, is narrower in scope than disclaimed claim 8 since it includes as limitations three additional features not found in claim 8.

The limitations which make claim 7 narrower than disclaimed claim 8 are:

1. Claim 7 specifies "*conveying means,*" and therefore adds another element, for instance, a wick by which moisture is transferred from the reservoir to the moistening roll, whereas claim 8 used the word "applying," which is broad enough to cover any and all arrangements whether or not they include an intermediate conveying element such as a wick. Both a tank and a wick can apply fluid, but only a wick or some other form of conduit can convey it.

*Claims 9 and 12 were not discussed by the Court of Appeals. However, claim 9 contains all three limitations found in claim 7. Claim 12 contains the first limitation and also specifies that the underside of the sheet is moistened, whereas claim 8 is broad enough to cover wetting either side of the sheet.

2. Claim 7 specifies an "intermittent gear," *i.e.*, a particular mechanism, for causing a dwell of the rolls during which the paper could be positioned, while claim 8 merely called for "means for intermittently rotating" and so was broad enough to cover any of many mechanisms which will produce intermittent rotation (compare the claims in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. at 19).

3. Claim 7 states that the intermittent gear is *adjustable*, whereas claim 8 says nothing about adjustability, and consequently covered all mechanisms whether adjustable or not.

Each of these differences is important.

Since claim 7 is narrower than claim 8, the monopoly which it secures to the patentee is not as broad as that asserted by claim 8. Claim 8 would be infringed by a machine which did not infringe claim 7; claim 8 would be held unlike claim 7 in a case of file wrapper estoppel; and claim 8 would be held invalid for failure to "distinctly claim," where claim 7 would be held to comply with R.S. Sec. 4888. We submit that the words "definitely distinguishable" in R.S. Sec. 4922 should be interpreted in the same manner.

III. The differences in the wording of the claims describe differences in the operation and result of the machines.

The three differences in wording of the claims pointed out in the preceding sections stand for corresponding differences in "operation and result," which is the test laid down by this Court in *Maytag* v. *Hurley*,* in which this Court said:

> "We think they describe but a single method. The company insists that the crucial difference lies in the

*307 U.S. 243.

fact that in 38 the moving fluid in the tub is said substantially to suspend the fabrics, whereas in 39 the same agency is said to cause the fabrics to be freely moved about. But the *verbiage* describes no difference in *operation or result*. We conclude that when read in their entirety, they describe the same method." (Italics ours.)

1. Conveying the moistening fluid to the roll by an additional element instead of applying it by a roll which dips in the fluid limits the amount of moisture put on the paper and lengthens the life of the master copy, because only a tiny amount of ink is dissolved off the master copy each time a copy is made, and each copy is uniform, clear and distinct. This difference in operation and result accounts largely for the success of the invention in suit.

2. Likewise the intermittent gearing specified in claim 7, but not in claim 8, operates differently and produces a different result, because it causes a dwell in the feeding and moistening rolls which permits the paper to be positioned by the bight of the rolls when stationary.

3. And finally making the intermittent gear adjustable enabled the operator to change the location of the printed matter on the clear sheet, moving it up or down as required. This also is a difference in operation and result.

The District Judge recognized that there was a difference in operation and result when he said:

> "The addition of the statement that the intermittent gearing is adjustably secured to the platen, though it may be of some practical consequence in the *results* of the *operation* of the machine . . ." (R. p. 25).

The Court of Appeals for the First Circuit disregarded these facts entirely, although they were pointed out in the briefs and in the petition for rehearing (R. p. 85).

IV. The Court of Appeals failed to apply the test of the Maytag case.

In the *Maytag* case, *supra,* this Court held that two claims which were in effect for the same method were not "definitely distinguishable," and said that they were the same because they described no difference in "operation or result."

The Court of Appeals in the case at bar did not rule that claims 7 and 8 were for the same apparatus, but only that they were not distinguished by the differences which were specified in the valid claims. The Court of Appeals not only ignored the difference in scope of the claims, but also avoided the question whether or not the differences in the claims resulted in differences in operation and result.

In *E. L. Bruce Co.* v. *Bradley Lumber Co.,* 79 F. Supp. 176, District Judge Miller ruled that a claim which specified "radiations predominantly infra-red in wave-length" was narrower than an invalid claim which claimed broadly "heat which penetrates" and therefore was "definitely distinguishable" and need not have been disclaimed. This decision is squarely contrary to the decision of the Court of Appeals in the case at bar, for it recognized that differences in scope which produce differences in operation and result render claims "definitely distinguishable."

The Court of Appeals arrived at its erroneous conclusion because of three mistakes:

1. As to the word "conveying" appearing in claim 7, the Court of Appeals said that it was not sufficient to distinguish claim 7 from claim 8 because "conveying" did not necessarily denote a wick. *There is no reason why it should have.* The significant fact is that it introduced a new and important element not present in claim 8.

2. As to the intermittent gears, the Court of Appeals said that intermittent gears were old in the art, *which was not so,* but it did not say, nor was there anything in the

record to show, that they were old in this combination. In fact, the combination was wholly new.

3. As to the adjustability of the intermittent gearing, the Court of Appeals said that the patentee did not intend "his feeding, moistening, positioning rolls to be anything but adjustable with reference to the platen," a remark which had nothing whatever to do with the comparative breadth of claims 7 and 8.

These comments show how inaccurate the thinking of the Court of Appeals was. The same reasoning would have required the patentee in the *Bruce* case* to have disclaimed the claim which was limited to an infra-red ray. The Court of Appeals for the First Circuit not only failed to give due weight to the differences in scope, but also ignored the differences in operation and result flowing from them, and so did not observe that the claims marked out different monopolies, and were therefore "definitely distinguishable."

V. The Court of Appeals has given the claims of the patent in suit a different meaning from that given to them by that court in the Ditto case; in filing its disclaimer, petitioner relied on that interpretation; it should not be penalized for the changed views of the Court of Appeals and did not "unreasonably neglect" to file a disclaimer.

In the *Ditto* case, the Court of Appeals (Judges Bingham, Wilson and McLellan) recognized that the central idea of this part of Storck's invention was the use of some intermediate agency such as a wick to transfer, *i.e.*, convey, moisture to the moistening roll, but did not limit the invention to the use of a wick alone (see App. A, p. 26). The present Court of Appeals (Judges Magruder, Maris

*79 F. Supp. 176.

and Woodbury), on the other hand, deny to the patentee the right to claim his transfer agency unless limited to a wick, thus treating this part of the invention as though it resided only in providing moisture by capillary attraction.

The Court of Appeals seems to have changed its position. But whatever the fact, the patentee should not be penalized because the Court of Appeals in its earlier decision failed to make itself clear.

A disclaimer is not necessary until facts which require it are brought home to the patentee with reasonable certainty.*

Accordingly, we respectfully submit that the patentee cannot be said to have "unreasonably neglected" to file a disclaimer.

VI. The public interest requires that the disclaimer statute should be clearly and definitely construed.

At the present time a patentee does not know whether two claims which are different in scope are "definitely distinguishable" within the meaning of the disclaimer statute. The public should know whether Judge Miller in the *Bruce* case, *supra*, was right in making difference in scope which results in difference in operation and result the test or whether the Court of Appeals for the First Circuit which rejected this test was right. The public should know whether different or the same tests apply when the dis-

*"The duty to disclaim begins when knowledge is brought home to the owner of the patent that the inventor upon whose account the patent was granted was not the first to disclose the particular thing claimed in the patent and material to it as a whole. O'Reilly et al. v. Morse et al., 15 How. 62, 56 U.S. 62, 121, 14 L. Ed. 601." *France Mfg. Co.* v. *Jefferson Electric Co.*, 106 F. (2d) 605, 610 (C.C.A. 6). See also *W. F. & John Barnes Co* v. *International Harvester Co.*, 51 F. Supp. 254 (D.C Ill.).

claimer statute is in question as when file-wrapper estoppel or a question of compliance with Section 4888 are in question.

Conclusion.

We respectfully submit that the public is entitled to know precisely what the phrase "definitely distinguishable" in the disclaimer statute means and whether or not a clear difference in scope between claims renders them "definitely distinguishable."

We respectfully submit that certiorari should be granted since the case raises a question of statutory construction and because the Court of Appeals for the First Circuit has gone contrary to the decision of this Court in the *Maytag* case.

Respectfully submitted,

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GEORGE P. TOWLE, JR.,

Attorneys for Petitioners.

Appendix A.

[From 100 F. (2d) 466.]

STANDARD MAILING MACHINES CO. v. DITTO, INC.

No. 3364.

Circuit Court of Appeals, First Circuit.
Dec. 28, 1938.

Appeal from the District Court of the United States for the District of Massachusetts; George C. Sweeney, Judge.

Patent infringement suit by the Standard Mailing Machines Company against Ditto, Inc. From a decree, 22 F. Supp. 722, holding certain claims invalid, and other claims valid but not infringed, the plaintiff appeals.

Affirmed in part, reversed in part and case remanded.

Before BINGHAM, and WILSON, Circuit Judges, and McLELLAN, District Judge.

BINGHAM, Circuit Judge.

This is an equity suit brought in the federal District Court for Massachusetts by the Standard Mailing Machines Company against Ditto, Inc., for alleged infringement of United States Patent No. 19,951, issued to Frederick W. Storck April 28, 1936; it being a reissue of a prior patent (No. 1,964,933) issued to said Storck July 3, 1934, on an application filed July 21, 1930. The application for reissue was filed December 10, 1935.

The District Court held claims 3 and 8 invalid for want of invention, and that claims 19, 20, 21, 22, 23, 30, 32, 34, and 40 were valid but, in view of the file contents of the application for the original patent (1,964,933), they should be narrowed in scope and thus narrowed, were not infringed. A decree having been entered accordingly, the plaintiff appealed.

The questions here involved are (1) whether claims 3 and 8 of the reissue patent are valid and, if valid, infringed, and (2) whether the remaining claims are infringed by the defendant's machine (Exhibit 4), which question involves a subsidiary one, namely, the scope to be given to the second group of claims in view of the file contents and the prior art. No question is raised as to the plaintiff's ownership of the original and reissue patents.

The plaintiff's device is known as a wet process machine for printing a substantial number of copies—from two to three hundred—of matter printed on an original or master copy. The master copy is printed in reverse on a typewriter, the carbon sheet being so arranged that it prints on the back of the first sheet instead of on the face of the next one. The carbon sheet is prepared with a special copying ink which is deposited in type form on the master copy. The amount of ink thus deposited is very slight, but it is a measurable amount. A clear sheet that has been moistened is then placed upon and pressed against the master sheet and a slight amount of moisture on the clear sheet is sufficient to soften the ink and produce a clear copy.

This wet process art for producing duplicate copies had existed for about thirty years at the time plaintiff's patentee obtained his patent, but the District Court found that the duplicating machines of that art had not proved successful because no means had been discovered for applying a sufficiently minute and uniform film of moisture over its entire area. If too little moisture was applied to the clear sheet a faint copy resulted; too much moisture made the ink run and washed it off the master sheet so that no more copies could be made. And if the moisture was not uniformly distributed throughout the clear sheet a faint copy resulted where there was too little moisture and

a dark or blurred copy where there was too much, and both of these defects might appear on a single sheet.

Storck's machine and mechanism applies a thin, uniform coat of moistening liquid over the entire surface of the sheet. In his machine for accomplishing this result a smooth roller made of glass or metal receives the liquid from a piece of felt or wick and deposits it in a sufficiently minute and uniform amount over the clear sheet on which the printing from the master sheet is to be made. The smooth surface of the roller takes from the felt or wick only so much moisture as will spread on its surface by the surface tension of the liquid and the attraction of the surface of the roller for the liquid. The result is that a very thin coat of moisture is spread over the surface of the roller and by it transferred to the surface of the clear sheet. In Storck's mechanism the wick and roller are the essential elements. Either without the other would not function effectively.

The claims covering this combination of wick or fibrous material and the roller are 19, 20, 21, 22, 29, 30, 32, 34 and 40.

[1] In claim 8 the main feature is the means for intermittently rotating the printing platen or drum in connection with means for rotating the feed rolls in unison with the drum and its pressure roll, for pressing the clear sheet against the master copy. We think that the District Court correctly held that claim 8 was invalid. Intermittent stopping and starting of feed rolls and master drum in unison for positioning a clear sheet to register with the master copy on the drum was old, as was also means for bringing a small amount of moistening fluid to the face of one of the rollers. Ritzerfeld Patent (1927) No. 1,645,930. Ritzerfeld discloses means for intermittent rotation of the feed rolls and drum in unison and means to bring a small amount of fluid to the face of one of the feed rolls. The claim is not sufficiently limited to escape the prior art.

[2] In claim 3 Storck combined in general terms means for moistening a clear sheet, on which the copy was to be made, with a provision for positioning the advanced end of the clear sheet by the bight of the feed rollers, so that, when that end had passed through the feed rollers, the clear sheet, on being received by the master drum and its pressure roll, would register properly on the master copy on the drum. The main feature of this claim is the positioning of the forward end of the clear sheet by the bight of the feed rolls when they are under tension and are stopped. The means for positioning the clear sheet are the only specific means called for by the claim. All the others are general and are disclosed in the patent above cited to Ritzerfeld. The question as to this claim, therefore, is whether it is valid by reason of the specific cooperative positioning means which it discloses.

The nearest reference in the prior art that has been called to our attention bearing on this question is the British patent to Albert Eltzbacher of March 23, 1895. The machine of that patent, however, is one for making a copy of a letter, the letter being positioned face down upon the clear sheet upon which the copy is to be made and then passed through feed rolls B and D. The specification of the patent states: "The paper [thus positioned] is brought between the rollers B and D by means of the table K, which terminates shortly before the line of contact of said two rollers." In other words, the bight between the rolls was not a positioning means in that machine. This device was a hand cranked machine. The clear sheet and the superimposed letter were put in registration before entering the rolls, and there was no occasion for further positioning the papers to register; and there was no master copy on a drum in that device to require registration.

The problem confronting the patentee of that invention was not the one which confronted Storck. Storck did not

have his master copy and the clear sheet superimposed upon one another before they were passed through the feed rolls. He had only the clear sheet. The master copy was on the periphery of the printing platen or drum, and, to obtain registration of the clear sheet with the master copy, it was essential that the advanced end of the clear sheet should be so positioned that it would register with the master copy on reaching the drum; and, to accomplish this he provided the bight formed by the feed rolls under pressure as his stop mechanism for positioning the clear sheets. In other words, he so arranged the feed rolls that they performed three functions—the positioning, the feeding and the moistening of the clear sheet. The prior art disclosed no such simple and practical mechanism for performing these combined functions. Ritzerfeld's and other prior art patents disclosed stops for positioning the clear sheets, but in those devices, when a certain point in the revolution of the feed rolls and drum was reached, the feed rolls separated, the drum stopped and the clear sheet was moved forward by the operator through the separated rolls and its advanced end was positioned by the stops. This complicated and involved mechanism for positioning the advanced end of a clear sheet fairly represents the state of the art for a substantial number of years and until Storck's invention appeared on the scene. The defendant and others since then have paid tribute to Storck by adopting his method of positioning the clear sheet. Even Ritzerfeld, in his later device, has adopted it. It is evidently one of the substantial elements in the plaintiff's device that has made it a practical machine and enabled it to achieve commercial success. We regard this claim as valid.

[3] Claims 32 and 34 may be properly classed with claim 3, so far as they call for the positioning of the advanced end of the clear sheet by the bight of the feed rolls. Claim 32 provides for "rotative feed rollers which engage one

another under pressure and form a bight therebetween adapted to receive and position the end of an advanced sheet to be duplicated upon." And claim 34 provides for "positioning, feeding and moistening a clear sheet to be duplicated upon to register and engage under pressure with said master copy sheet, said means comprising opposed feed rollers in engagement with one another under pressure." These claims we regard as valid on account of this novel feature, whether they could be regarded so or not because of some other features which they disclose.

[4] The defendant contends that its device does not infringe claim 3 for the reason that it does not have the automatic intermittent stopping and starting features which plaintiff's claim 3 discloses for positioning the clear sheet by the bight of the feed rolls.

For the purposes of this case it is unnecessary to decide whether the defendant's machine infringes claim 3 of the patent, for it is manifest that it infringes claims 32 and 34, irrespective of the automatic stopping feature of claim 3, or whether their scope, due to the character of their moistening means (fibrous material), is or is not limited. The District Judge ruled that claims 32 and 34 and the remaining claims 19, 20, 21, 22, 29, 30 and 40 were valid, but were limited and not infringed by reason of what the patentee's lawyer said in the Patent Office with reference to a claim not here in issue, which the Examiner had suggested, with certain other claims, for an interference proceeding between Storck and one Charles Wesley Jean. The suggested claim read:

"In a copy-multiplying device, means for moistening the sheets to be printed comprising a roller having a non-absorbent surface, a moisture reservoir spaced therefrom and means for transfering moisture from said reservoir to said roller surface."

Before the parties were put in interference the suggested claim was amended by inserting in the third line after the word "means" and before the word "for," the words "comprising a wick"—counsel for Storck having stated before the amendment was made that the mooted claim was anticipated by the structure shown in the Thompson patent "unless the words 'means for transfering moisture from said reservoir to said roller surface' is construed to mean a wick and capillary action." This is the statement referred to by the District Judge in his opinion and because of which he held that the claims now under consideration should be limited to means operating by capillary attraction alone for transfering the liquid to the moistening roll for moistening the clear sheet. But the amendment of the suggested claim was less restricted than this and provided a wick, however it might operate in transfering the liquid to the moistening roll. The suggested claim, as thus amended, is not here in issue, and was not included in the claims of the reissue patent. *Some claims were allowed in which the moistening agency was expressly limited to a transfer of liquid to the roll by capillary attraction, but that is not true of the claims here in question. In this situation the plaintiff is not estopped from having the benefit of the provisions of the claims specifying a "wick" or "fibrous material" as an agency for transfering liquid to the moistening roll without regard to the theory on which they may operate,** for that depends largely upon how the agency is positioned, as to which the patentee is not limited in these claims.

[5, 6] The District Court held all these wick or fibrous material claims valid and not anticipated. With this we are in entire accord. We are also of the opinion that these claims are not limited in the manner held by the District

*Italics ours.

Court. It necessarily follows that the defendant infringes the positioning provisions of claims 32 and 34, their moistening provisions also being held valid. It also infringes all the other claims in issue containing the moistening elements of a "wick" or "fibrous material." The defendant in its device has the upper roll as its moistening roll, and the lower one for the feed roll under pressure, and uses a wick or fibrous material to transfer the liquid to the moistening roll.

[7] The Commissioner's action in allowing an amendment to the specification and claim 3 of the original patent, so that in the reissue patent they would state more clearly the feature of the positioning of the clear sheet by the bight of the feed rolls, was proper, the specification and claim 3 of the original patent manifesting a clear intention to disclose and claim this feature of the invention, and show that the failure more clearly to state it in the original patent was due to inadvertence, accident or mistake. Stafford Co. v. Coldwell-Gildard Co., 1 Cir., 202 F. 744, at page 745; Northrop v. Draper Co., 1 Cir., 239 F. 719; Rev. Stat. Sec. 4916, 35 U.S.C.A. § 64.

[8] The reissue patent is not invalid for laches in applying for it. It was applied for in much less than two years after the grant of the original patent. The amended claims are not broader than the original ones and the same is true of the new claims here in issue. Walker on Patent (Deller's Ed.), Secs. 324, 325.

[9] On further examination of the evidence and the operation of the defendant's device (Exhibit 4), we are satisfied that the latter stops automatically when the platen or drum reaches the desired point for positioning the clear sheet by the bight of the feed rolls and infringes claim 3 of the patent in issue.

The decree of the District Court is affirmed as to claim 8; it is reversed as to claim 3 and also insofar as it limits

the scope of claims 3, 19, 20, 21, 22, 29, 30, 32, 34 and 40; all the claims here in issue except claim 8 are valid; and claims 3, 19, 20, 21, 22, 29, 30, 32, 34 and 40 are infringed. The appellant recovers costs in this court and in the court below. The case is remanded to the District Court for further proceedings not inconsistent with this opinion.

Appendix B.

Revised Statutes, Sec. 4917.

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Revised Statutes, Sec. 4922.

Whenever, through inadvertence, accident or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Appendix C.

REVISED STATUTES, SEC. 4888.

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most

nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

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Supreme Court of the United States.

OCTOBER TERM, 1949.

No. 231.

STANDARD DUPLICATING MACHINES COMPANY, INC.,
Petitioner,

v.

AMERICAN BUSINESS MACHINES CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Subject Index.

	Page
Outline of the case	3
Argument	5
1. A difference in scope is not per se sufficient to render claims definitely distinguishable	5
2. Claim 7 expresses no concept not found in claim 8	12
(a) "Convey" vs. "apply"	12
(b) The intermittent gear	13
(c) Adjustability	14
3. The alleged conflict	15
Conclusion	15

Table of Authorities Cited.

Cases.

Apex Electrical Co. v. Maytag Co., 122 F. (2d) 182 5, 8, 9

Bulldog Electric Products v. Cole Electric Products Co., 148 F. (2d) 792 5, 6, 7, 8

Duraloy Co. v. Carnegie Illinois Steel Corp., 43 F. Supp. 291 5, 9, 14

E. L. Bruce Co. v. Bradley Lumber Co., 79 F. Supp. 176 6, 11, 15

Ensten v. Simon, Ascher & Co., Inc., 282 U.S. 445 2

Maytag Co. v. Hurley Machine Co., 307 U.S. 243 5, 6, 7, 9, 10

Standard Mailing Machine Co. v. Ditto, Inc., 100 F. (2d) 466 3

Wiegand v. H. E. Trent Co., 122 F. (2d) 923 6, 9, 10

Statute.

Disclaimer Statutes, R.S. secs. 4917, 4922, 35 U.S.C. secs. 65, 71 1

Textbook.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petitioner seeks by its petition to upset the decision of the United States District Court, reported 77 Fed. Supp. 871, and the affirming decision of the Court of Appeals for the First Circuit, reported 81 U.S.P.Q. 239; rehearing denied May 19, 1949.

This is a patent case concerning the application of the Disclaimer Statutes, R.S. secs. 4917 and 4922, 35 U.S.C. secs. 65 and 71. Both sections relate to the predicament of a patentee who discovers that he has inadvertently claimed in his patent more than he had invented. Ordinarily the fact appears when a court holds one or more of the patent claims to be invalid, as happened in the case at bar.

The deep-rooted abhorrence of the public for illegal monopolies was responsible for the common-law doctrine that, if any claim was held invalid, the entire patent fell.

Ensten v. *Simon, Ascher & Co., Inc.*, 282 U.S. 445. The holding of invalidity of one claim was in fact an adjudication that the patentee had been asserting an illegal monopoly in derogation of the interests of the public. The British Statute of Monopolies of 1623 (Walker on Patents, 1937 Edition, vol. 1, p. 18) carefully distinguished between illegal monopolies (prescribing penalties against those found guilty of asserting them) and the monopoly which might lawfully be granted to the inventor or discoverer of something which was not before known. Consequently the loss of the entire patent was regarded as a penalty properly imposed against one who had asserted an illegal monopoly by claiming in his patent more than that which he had invented.

We strike this note at the outset because the petitioner's case entirely disregards considerations of public policy and completely overlooks the philosophy underlying the disclaimer statutes. Congress passed the disclaimer statutes because it was felt that the loss of the entire patent was perhaps in certain cases an unnecessarily harsh penalty. Consequently it was provided that, where the assertion of the illegal monopoly was due to innocent inadvertence, accident or mistake, the patentee should be given the privilege of salvaging by disclaimer so much of his patent as truly defined an invention.

There are two conditions imposed upon a disclaiming patentee. The first condition is that the disclaimer be filed promptly, a requirement obviously imposing upon the patentee the duty to excise the invalid claims without delay in order to end the assertion of an illegal monopoly. The second requirement is that the patentee disclaim everything not "definitely distinguishable from the parts claimed without right." In view of the historical background of this subject, it is our contention that, where there is a doubt as to whether one claim is definitely distinguish-

able from another, that doubt should be resolved *in favor of the public.* The petitioner, on the other hand, attempts to induce the Court to believe that in case of doubt the matter should be resolved in favor of the patentee. Such an interpretation would obviously conflict squarely with the *raison d'être* of the disclaimer privilege.

Outline of the Case.

Coming now to a consideration of the facts to which the preceding general remarks may be applied, we find that the Storck patent in suit was in issue in *Standard Mailing Machine Company* v. *Ditto, Inc.,* 100 F. (2d) 466. The outcome of that suit was an adjudication that certain claims were valid but that claim 8 was invalid. Within a reasonably prompt time after the issuance of the decision petitioner disclaimed claim 8. The Court of Appeals for the First Circuit has now held in this case that the patent in suit is invalid as to all of its claims because petitioner should have disclaimed claim 7 as well as claim 8, the reason being that claim 7 was not "definitely distinguishable" from claim 8 within the meaning of the statute.

For the sake of the convenience of the Court we reproduce below, in side-by-side comparison, the two claims now in issue.

"8. In a machine for producing duplicate copies of matter printed in reverse on a master sheet,	"7. In a machine for producing duplicate copies of matter imprinted in reverse on a master sheet with copying ink,
a frame,	a stationary frame,

a printing platen revolvably mounted in said frame,	a printing platen rotatably mounted in said stationary frame,
means for securing said master sheet to said printing platen,	
means for intermittently rotating said printing platen,	an intermittent gear adjustably secured to said printing platen to intermittently rotate it,
a pair of feed rolls for feeding a clear sheet of paper,	combined feeding and moistening rolls mounted in said stationary frame,
means for applying a limited film of volatile moistening fluid to the face of one of said feed rolls to be deposited on a clear sheet of paper as it passes between said pair of feed rolls,	means to convey moistening fluid to one of the said rolls,
means for revolving said feed rolls in unison with the rotative movement of the printing platen and a pressure roll for pressing the clear sheet against the master copy."	means for rotating said feeding and moistening rolls in unison with said printing platen to feed a clear sheet to contact with a master sheet secured to said printing platen and means to press said clear sheet against the master sheet."

Argument.

This case does not present any conflict whatsoever with previously decided cases. The decisions of the District Court and the Court of Appeals in this case are in complete accord and harmony with each other and with the six reported cases on this subject matter. There is no "important question of federal law" which is here presented for the Court's decision; every point raised by petitioner has been adequately covered in previous decisions.

No difficulty has been experienced by the public in understanding or interpreting the statutes involved; and the recorded decisions are ample to give any unbiased lawyer a clear understanding of this phase of patent law.

The petitioner, in its zeal for another hearing, has repeated at length its arguments on the merits unsuccessfully made before the appellate court. But certiorari jurisdiction is not exercised by this Court to give a defeated party another hearing.

1. A Difference in Scope is Not Per Se Sufficient to Render Claims Definitely Distinguishable.

Petitioner states that "the primary question is whether two claims, one of which is narrower than the other, i.e., of different scope, are on that account 'definitely distinguishable' from each other." There are only six reported cases which deal with the issue of whether two claims are "definitely distinguishable." They are—

Maytag Co. v. *Hurley Machine Co.*, 307 U.S. 243.
Bulldog Electric Products v. *Cole Electric Products Co.*, 148 F. (2d) 792.
Apex Electrical Co. v. *Maytag Co.*, 122 F. (2d) 182.
Duraloy Co. v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291.

Wiegand v. *H. E. Trent Co.*, 122 F. (2d) 923.
E. L. Bruce Co. v. *Bradley Lumber Co.*, 79 F. Supp. 176.

The first five of these six cases happened to involve situations in which the claims compared were held *not* to be definitely distinguishable. The Bruce case involved a ruling that two claims *were* "definitely distinguishable," for what we believe to be entirely adequate reasons. In every one of the first five cases the two claims compared were different in scope. For example, in the Maytag case, which involved a washing machine, disclaimed claim 38 merely required that the opposed currents of fluid "flow inwardly," whereas claim 39 added the further limitation that the currents meet and flow not only inwardly but also vertically toward the source of agitation. Obviously, it would be possible to construct a washing machine in which the currents met and flowed inwardly without flowing vertically. Moreover, in claim 38 there was the requirement that the clothes be *suspended,* but in claim 39 there was the different requirement that the fabrics *"be freely moved about."* Thus the two claims differed in scope. The real sense of Mr. Justice Roberts' opinion was that the claims were obviously directed to the same concept in spite of the fact that one claim was more explicit than the other on one point.

In the Bulldog case the claims compared were as follows:

"13. A sectional duct run comprising duct sections joined end to end and divided longitudinally into cooperating members, one of

"14. A sectional duct run comprising duct sections joined end to end and divided longitudinally to provide similar and comple-

which overlaps the other at one end and underlaps the other at the other end, a group of bus runs in the duct run symmetrically and similarly disposed with respect to the opposed surfaces of the members, plug entrances on opposite sides of the duct, the entrances on one side being longitudinally offset from the entrances on the opposite side so that a bus run part exposed to one entrance is not exposed to the opposite side entrance."

mentary duct halves provided with external flange means for joining the halves longitudinally and for providing anchorages for the duct run, the duct halves being so arranged that one overlaps the other at one end and underlaps the other at the other end, the flanges providing means for joining neighboring duct sections in end to end relation, a group of bus runs in the duct run symmetrically and similarly disposed with respect to the meeting and joining lines of the duct halves."

In the first place it will be observed that the claims in the Bulldog case were directed to structure, whereas the claims in the Maytag case were directed to a method; it is therefore established that the doctrine of the Maytag case is applicable to patents on structure, as well as to patents on process. Claim 13 had been disclaimed and the issue in the Bulldog case was whether claim 14 was or was not "definitely distinguishable" from claim 13. It is important to note that claim 14 is *narrower in scope* than claim 13. For example, claim 13 calls for duct sections divided longitudinally "into cooperating members," whereas in claim 14 the members are not only divided longitudinally but are divided to produce "similar and complementary duct halves." Moreover, the duct halves in claim 14 were limited to those provided with external flange means for

joining the halves longitudinally. If it were true that a narrower claim is *ipso facto* "definitely distinguishable" from a broader claim, as appellant would have the Court believe, claim 14 in the Bulldog case would have to have been held "definitely distinguishable" from claim 13.

But the Court held as follows:

> "Despite the differences in the language, what each of the claims covers when read on the specifications in the patent is not definitely distinguishable from the coverage of the other. We think it obvious that they cover the same construction though the claims show minor differences in details which neither add to nor detract from what is claimed as the patentee's invention."

The Apex case also expresses the same refusal of a court to hold claims definitely distinguishable although obvious differences in scope existed between them. We reproduce here the claims considered in the Apex case.

"3. The combination with a base, of a support adjustably arranged on the base, a driven shaft on the support, a retaining device acting to hold the support in adjusted position on the base, and means cooperating with said retaining device and acting to prevent its disengagement from the base when the driven shaft is running and permit such disengagement when the driven shaft is idle."

"4. The combination with a base, of a support rotatively mounted on the base, a driven shaft on the support, a slidable retaining pin acting to hold the support in adjusted position on the base, and means cooperating with said retaining pin and acting to prevent its disengagement from the base when the driven shaft is running and to permit such disengagement when the driven shaft is idle."

It will be noted that claim 4 is narrower than claim 3, again demonstrating the fact that a difference in scope is not enough *per se* to render two claims definitely distinguishable. Claim 3 recites merely "a retaining device acting to hold the support," while claim 4 specifies "a slidable retaining pin acting to hold the support." A machine could be built which would infringe claim 3 of the Apex case without infringing claim 4 (by the use of a retaining device other than the slidable pin), but the Court held:

> "That claims 2, 4 and 8, here relied on, are not definitely distinguishable from the disclaimed claims 1, 3, 5, and 11 we think there can be no doubt."

Another case of importance is *Duraloy Co.* v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291. The gist of the Duraloy case was that, when two claims differed only in that an element in only one of them was required to be "adjustable," the claims were not "definitely distinguishable" within the meaning of the Maytag doctrine. Judge McVicar pointed out that the specification of the patent involved in the Duraloy case made no particular point of the adjustability of the element concerned. The implication is that the claims were held not definitely distinguishable because one did not express a concept of invention any different from that expressed in the other.

In the Wiegand case the Court of Appeals for the Third Circuit upheld Judge Kirkpatrick's decision that in three separate patents there were sets of claims not distinguishable from others which had been disclaimed in those patents. In this connection Judge Kirkpatrick's language is extremely cogent. He held, in respect to the first patent, the only difference between two claims to be that in one of them the material was "artificially compacted," whereas the other claim called for compacting the material by "sub-

jecting the element to pressure." He made the following statements:

> "It is no answer to say that a device could be found or has been found which would infringe claim 1 but not infringe claim 2. The real point is that whatever distinction may exist between the two claims is upon a point which has not the slightest real bearing upon the essence of the patent."

The last sentence should be written in letters of brass because it expresses with exceptional clarity the very heart of the law which should be applied to this case.

Again, in the third patent considered by Judge Kirkpatrick the only substantial difference between the disclaimed claim and the other claim not disclaimed was that the disclaimed claim recited a heating element generally, while the other claim required that the heating element be in the form of a strip. The judge stated:

> "A strip heater is merely one form adapted to the convenience of users for certain purposes. No one contends that the form—strip, disc, or ring—has anything to do with the invention claimed."

It should be noted that, in all three of the patents involved in the Wiegand case, the *disclaimed claim was broader than the claim not disclaimed*—not only that, the trial judge commented on the differences in scope and specifically said that it made no difference for purposes of the Maytag rule that a device could be built which would infringe only one of the two claims compared.

In every one of these cases the claims compared are different in scope, one being broader than the other, and yet in every one of those cases the claims were held not to be definitely distinguishable within the meaning of the statute.

We respectfully submit that it would be a work of supererogation at this late date to re-examine the matter and again declare as law that which the five cases above discussed have already abundantly made clear.

In the Bruce case there was involved a patent relating to a method of finishing wood, particularly flooring, by applying to it certain oils and compounds and then subjecting the wood to heat. Now claim 1 had been disclaimed; it called for the use of "heat which penetrates." Claim 2, which had not been disclaimed, specified "heating by radiation which is predominantly infra-red in wave length." The Court held that these two claims were definitely distinguishable.

> "Any type of heat will penetrate but only heat by radiation will penetrate the object as a ray and turn into heat within and be absorbed by the object. Radiation heats not from the outside in but from the inside out."

There was a clear difference in *concept*, and we submit that the Court reached the right conclusion. To refer back to Judge Kirkpatrick's decision, it strikes us that the Bruce case is a good example of where the distinction between the two claims is upon a point which *does have* "real bearing upon the essence of the patent." It should also be noticed that the claims in the Bruce case clearly pointed out the significant difference; it was there for anyone to read. It did not require devious sophistical argument to develop it. Another point should be noted: Obviously the claims in the Bruce case would differ in scope, very definitely so; however, the claims were not held to be distinguishable merely because their *scopes* differed, but because the specification of heat by radiation in the infrared wave length region very definitely involved a depart-

ure in *concept,* and in essence, and had a real bearing on the invention.

Reduced to its essentials, petitioner's argument leads to the erroneous conclusion that one claim is definitely distinguishable from another if it be more specific in its terms than the other. Petitioner states at page 12: "Likewise, a more specific definition of one of the elements makes a claim narrower." Petitioner states that claim 8 was too broad, and therefore invalid, but a broad invalid claim is not rendered valid merely because it is rewritten to be more specific. The rewriting must define an invention. In other words, if the concept expressed in a claim is not patentable, it is of no avail to describe that unpatentable concept in more specific terms. The important thing in any claim is that it clearly and distinctly point out *an invention.*

2. Claim 7 Expresses No Concept Not Found in Claim 8.

(*a*) *"Convey" vs. "Apply."*

Disclaimed claim 8 contains the expression: "means for applying a limited film of volatile moistening fluid to the face of one of said feed rolls." Claim 7 reads in part: "means to convey moistening fluid to one of said rolls."

Petitioner argues that "convey" is a more limited term than "apply." However, the opinion of the Court of Appeals disposed of this contention (R. p. 79):

> "Moreover, patents are not to be read with the attention focused solely upon an unabridged dictionary and an English grammar. The purpose of a patent is to disclose the invention described therein to the public, that is, to the part of the public skilled in the art to which the patent appertains, and hence they are to be read as those conversant with the art involved would

read them. And so read the plaintiff's argument falls to the ground."

The specification of the Storck patent does not bear out the special meanings petitioner desires to read into "apply" and "convey." We find in the specification the following words used synonymously: "apply," "deposit," "supply," "feed," "spread," "distribute."

Moreover, the Storck specification reads (R. p. 15, col. 1, lines 22-34):

> "It is to be noted that the wick alone is relied upon to supply moisture to the damping roller in the preferred form of my invention shown in Figs. 1, 2, 3, 5 and 6, and in such form I prefer to use a closely compacted, degreased, wool felt which feeds the liquid slowly and spreads it very evenly upon the face of the damping roller, and wherever in the following claims I use the term 'sole wick means' for supplying moisture, I hereby intend to exclude any means, such as immersion of the damping roller in the liquid as added means, for applying moisture to the damping roller in conjunction with the wick means."

Storck, then, used the word "apply" as descriptive of the wick action. He nowhere stated that the word "convey" was limited to a wick or excluded the wallower roll as "*added* means for *applying* moisture" (italics ours).

(*b*) *The Intermittent Gear.*

Claim 7 calls for "an intermittent gear adjustably secured to said printing platen to intermittently rotate it."

Disclaimed claim 8 reads in part: "means for intermittently rotating said pivoting platen."

In the specification, R. p. 15, col. 2, line 5:

> "The intermittent gears 55 and 56 are of the *usual construction* . . ." (italics ours).

At R. p. 16, col. 1, line 73, he stated:

> "I do not, however, wish to be limited to the form shown, as it is apparent that modifications may be made *in the form* and arrangement of the parts without departing *from the spirit of my invention*" (italics ours).

We submit that to utilize the "usual" intermittent gear (which was old in the art, R. pp. 24, 82) in place of some other means for securing intermittent rotation was not a difference in concept sufficient to render one claim definitely distinguishable from the other.

(c) *Adjustability.*

Petitioner argues that, because the intermittent gear is described in claim 7 as adjustable, the claim therefore is definitely distinguishable from claim 8. The District Court found that this difference "adds nothing of substance to claim 8 for purposes of the Maytag rule." The specification of the patent offers no explanation which would be helpful. Consequently both lower courts followed *Duraloy Co.* v. *Carnegie Illinois Corporation,* 43 F. Supp. 291. The Court of Appeals held: "There is nothing anywhere in the patent to indicate that Storck intended his feeding-moistening-positioning rolls to be anything but adjustable with reference to the platen."

3. The Alleged Conflict.

Petitioner alleges that the decision of the Court of Appeals here is in conflict with *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176. That case, as we have pointed out above, involved a claim which expressed a concept not suggested at all in the disclaimed claim. Consequently there is no conflict between that case and the case at bar, where claim 7 completely fails to present any important concept or thought not found in disclaimed claim 8.

Conclusion.

This case offers no questions of importance. The law is clear. Petitioner's "points," "questions," and "reasons" offered in support of the petition boil down to a dissatisfaction with the facts found by the lower courts and not with the law applied to them. In other words, petitioner really asks this Court to hold that "conveying" is definitely distinguishable from "applying"; that an "intermediate gear" for rotating a member is definitely distinguishable from "means for intermittently rotating" the same member; and that a member which is adjustable is dramatically different from a member which may or may not be adjustable.

Two courts have considered these same contentions and have been unimpressed; we are confident that this Court will not disturb opinions so clearly in accord with public policy.

Respectfully submitted,

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Supreme Court of the United States.

OCTOBER TERM, 1949.

STANDARD DUPLICATING MACHINES COMPANY, INC.,
Petitioner,

v.

AMERICAN BUSINESS MACHINES CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER.

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Subject Index.

Page

1. Respondent argues that public policy requires that doubts as to the necessity of a disclaimer "should be resolved in favor of the public," i.e., against the patentee 1
2. Respondent argues that the six cases involving interpretation of the phrase "definitely distinguishable" show that a difference in scope is not enough to differentiate claims 2
3. Respondent argues, pages 11 to 14 of its brief, that a difference in concept is required to render two claims "definitely distinguishable" 5

Table of Authorities Cited.

CASES.

Apex Elec. Co. v. Maytag Co., 122 F. (2d) 182 3

Bulldog Elec. Products v. Cole Elec. Products Co., 148 F. (2d) 792 2

Duraloy Co. v. Carnegie Illinois Steel Corp., 43 F. Supp. 291 3

E. L. Bruce Co. v. Bradley Lumber Co., 79 F. Supp. 176 2, 4, 5

Maytag Co. v. Hurley Machine Co., 307 U.S. 243 1, 2, 3, 4, 5

Wiegand v. H. E. Trent Co., 122 F. (2d) 923 3

Wiegand v. H. E. Trent Co., 43 U.S. P.Q. 149 3

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REPLY BRIEF FOR PETITIONER.

1. Respondent argues that public policy requires that doubts as to the necessity of a disclaimer "should be resolved in favor of the public," i.e., against the patentee.

This argument has no bearing on whether certiorari should be granted. We submit that the writ should be granted because the case raises an important question of Federal law which has not been settled by this Court, viz.: Are claims which differ from each other in the breadth of the monopoly claimed definitely distinguishable from each other? Also, the writ should be granted because the Court of Appeals for the First Circuit has decided an important question of Federal law in a way in conflict with the decision of this Court in *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243.

The patentee in the case at bar may or may not be guilty of asserting an illegal monopoly, depending on how the fundamental question stated above is answered. The question should be answered once for all, so that patentees will not be tempted to assert too extensive monopolies on

the excuse of differing facts, and the public can tell as a matter of law whether or not the legal monopoly is being exceeded.

Public interest requires a clear, definite rule as to the necessity for a disclaimer.

Until this Court squarely decides whether or not a difference in scope renders claims definitely distinguishable, the public and the patentee will be left in a state of uncertainty and the courts will be burdened with unnecessary litigation over questions of fact.

2. Respondent argues that the six cases involving interpretation of the phrase "definitely distinguishable" show that a difference in scope is not enough to differentiate claims.

In none of the cases in question except the *Bruce* case [1] did the difference in wording of the claims affect the breadth of the monopoly granted.

Respondent discusses the facts of the *Maytag* case, *supra,* but the discussion is beside the point because the Court found expressly that the claims (38 and 39) "described but a single method" and were "the same except in verbiage." Therefore, the case raised no question as to the necessity of a disclaimer where a difference in scope existed.

As to the Bulldog case,[2] respondent again discusses the facts but overlooks the statement by the court that the claims cover the same construction and, therefore, were not definitely distinguishable. The court said:

> "Despite the difference in language, *what each of the claims covers* when read in the light of the specifi-

[1] *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176.

[2] *Bulldog Electric Products* v. *Cole Electric Products Co.*, 148 F. (2d) 792, 794.

> cation in the patent is not definitely distinguishable *from the coverage of the other.*"

The case, therefore, is the same as the *Maytag* case in this respect and did not hold that a difference in scope does not render claims definitely distinguishable. In addition, it is to be noted that the differences between the two claims related to minor details of construction which had nothing to do with the essence of the invention.

In the Apex case[3] the gist of the invention was apparently the "means cooperating with said retaining device and acting to prevent its disengagement." As far as the invention is concerned, the particular form which the retaining device took—whether it was a pin or something else—was of no consequence. Each claim asserted the same monopoly against the public.

In the Duraloy case[4] the statement of facts is too meager to permit an analysis of the claims, but the court seems to have believed that the feature of adjustability, which was the only distinction between the claims, had nothing to do with the alleged invention.

In the Wiegand case[5] three patents were held invalid for failure to disclaim. The grounds appear best from the decision of the District Judge.[6]

As to the first of these patents, the court said:

> "The real point is that whatever distinction may exist between the two claims is upon a point which has not the slightest real bearing upon the essence of the real invention."

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[3] *Apex Electrical Co. v. Maytag Co.*, 122 F. (2d) 182.
[4] *Duraloy Co.* v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291.
[5] *Wiegand* v. *H. E. Trent Co.*, 122 F. (2d) 923.
[6] *Wiegand* v. *H. E. Trent Co.*, 43 U.S. P.Q. 149.

As to the second patent the court said:

> "It seems plain that this is a trivial detail of construction, having little, if anything, to do with the object of the patent."

And as to the third patent, the court said:

> "No one contends that the form—strip, disk, or ring —has anything to do with the invention claimed."

It is clear that in each case the monopoly asserted by the two claims did not differ in scope or extent.

In the *Bruce* case[7] the invalid claim called for "heat which penetrates," whereas the narrow claim specified "radiation, predominantly infra red in wave length." Heat applied externally, although it penetrates, did not produce the effect produced internally by infra-red rays. One claim was broad enough to cover many methods of heating; the other covered only one and there was, therefore, a clear difference in scope at the exact point of novelty, and this difference produced a difference both in "operation and result" as required by the *Maytag* case. We submit that the *Bruce* case squarely decided that two claims which were different in scope were "definitely distinguishable" within the meaning of the disclaimer statute.

Respondent, in its paragraph on page 5 headed "Argument," says: "The present case does not present any conflict whatsoever with previously cited cases."

This is clearly incorrect since the Court of Appeals in the case at bar held that two claims which were admittedly different in scope were not on that account definitely distinguishable, while in the *Bruce* case the court reached the contrary conclusion. The case at bar does not present any conflict of decision between Circuit Courts of Appeals

[7] *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176.

but the reasoning of the Court of Appeals for the First Circuit in the case at bar is squarely in conflict with that of the District Judge in the *Bruce* case.

3. Respondent argues, pages 11 to 14 of its Brief, that a difference in concept is required to render two claims "definitely distinguishable."

The function of the claims of a patent is to state the "metes and bounds" of the monopoly granted by the patent. Like the boundaries described in real-estate deeds, they define the territory which is the sole property of the patentee. The phrase "definitely distinguishable" in the disclaimer statute refers to the metes and bounds of the monopoly. To be definitely distinguishable, the territories covered by the claims must not be coextensive, since, if they were, there would be no difference in "operation or result" as required by the *Maytag* case. Respondent's "concept" theory, therefore, goes far beyond the rule of the *Maytag* case. Although it did not adopt respondent's concept theory explicitly, the Court of Appeals went contrary to the decision of this Court in the *Maytag* case in holding that the claims were not definitely distinguishable notwithstanding differences in "operation and result" which went to the very essence of the invention.

In conclusion, we submit that the writ of certiorari should be granted, *first*, because a question of the interpretation of a Federal statute is raised and, *second*, because the Court of Appeals for the First Circuit has decided the case contrary to the decision of this Court in the *Maytag* case.

Respectfully submitted,

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